UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,530	06/25/2003	Sophie Wastiaux	Serie 6126	2185

7590 01/10/2007

Linda K. Russell
Air Liquide
2700 Post Oak Blvd., Suite 1800
Houston, TX 77056

EXAMINER	
WARTALOWICZ, PAUL A	
ART UNIT	**PAPER NUMBER**
1754	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/10/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/603,530	WASTIAUX ET AL.	
	Examiner	Art Unit	
	Paul A. Wartalowicz	1754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10/26/06*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *22-25* is/are pending in the application.

4a) Of the above claim(s) *24 and 25* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *22 and 23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 23 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant's specification does not have support for the amendment "said joining pieces having a geometry such that there is no internal welding required on said joining pieces".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 23, the recitation "said joining pieces having a geometry such that there is no internal welding required on said joining pieces" renders the claim indefinite. Specifically, "internal welding" does not appear to be clearly defined in the specification.

Is "internal welding" meant to be welding on the interior of a pipe or similar equipment wherein there is an exterior and interior? The current claims do not make such a distinction and therefore the designation of "interior welding" is treated as arbitrary for the purpose of further examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 22 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Bland et al. (2895747).

With respect to claims 22-23, Bland et al. teaches different embodiments which anticipate the claims.

In first embodiment, Bland et al. teaches (see Figures 1-3), a method of protecting pieces of equipment (11 and 18) where the pieces have been protectively coated (14) and are joined to each other by welding (21) of the pieces together with a joining piece (12) which also has the protective coating (14) thereon. More specifically, Bland et al. teaches that after coating the member 11 and joining piece 12 (Column 2,

lines 24-26) weld 21 is made joining members 11, 18, and 12 integrally (Column 2, lines 49-52). The equipment pieces and joining pieces are all steel, and the protective coating shown in the figures is an aluminum coating (Column 3, lines 38-41 particularly).

In a second embodiment, Bland et al. teaches (see Figure 4) a method of protecting pieces of equipment (32, 37) where the pieces have been protectively coated (38, 34) and are joined to each other by welding (41) of the pieces together with joining pieces (39, 31) which also have the protective coating (34) thereon. More specifically, Bland et al. teaches that the pipe 32 and ring 31 are coated with aluminum (Column 3, lines 44-45) and after that pipe 37 is placed in position and a weld (41) is made to join pipes 32 and 37 and to weld ring 33 to the pipes (Column 3, lines 58-60). The equipment pieces and joining pieces are all steel, and the protective coating shown in the figures is an aluminum coating (Column 3, lines 38-41 particularly).

Regardless of which embodiment is relied upon, further limitations including fluids to be used in the equipment made, use in high temperature processes and the process in which the equipment made may be used merely recite intended use as claimed; nonetheless it would appear the method of Bland et al. would provide equipment capable of performing these intended uses as claimed since Bland et al. teaches that the equipment is known to have widespread use "in chemical reactors and the like and particularly in reactors associated equipment which are alternately exposed to reducing and oxidizing atmospheres" (column 1, lines 22-25).

With respect to portion "a" of claim 22, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention

and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Regarding, the limitation of "said joining pieces having a geometry such that there is no internal welding required on said joining pieces"; the prior art is regarded as teaching this limitation in both embodiments. Further, upon cancellation of the new matter limitations, the prior art rejections are recited as above.

Claim 22 is rejected under 35 U.S.C. 102(b) as being anticipated by GB 824717. GB 824717 teaches the process of producing corrosion-resistant equipment, specifically metal hollow bodies to be welded (page 1, lines 56-70) and refers specifically to carbon steel, iron pipe (page 1 lines 34 and 50), and further specifically defines the components of the figures as being carbon steel and corrosion resistant steel (page 2, lines 99-106). GB 824717 teaches (see Figure 2 or 3) that the components are connected by butt-welding (2) sleeves 3a and 3b together which sleeves are butt-welded (4) to components 1a and 1b and further that components 1a and 1b are protectively coated (5) and that the protective coating (5) covers at least a portion of the joining pieces (sleeves 3a and 3b); in Figure 2 the protective coating (5) is shown to partially cover sleeves 3a and 3b though the overlapping portion has no reference number while in

Figure 3 the protective coating (5) is shown to partially cover sleeves 3a and 3b as shown by reference number 4a.

Further limitations including fluids to be used in the equipment made, use in high temperature processes and the process in which the equipment made may be used merely recite intended use as claimed; nonetheless it would appear the method of GB 824717 would provide equipment capable of performing these intended uses as claimed since GB 824717 teaches that the equipment is known to be produce "hollow metal bodies, such as containers, apparatus, or pipelines for corrosive liquid or solid substances, gases, or vapours, mixtures, or suspensions" (page 1, lines 56-60).

With respect to portion "a" of claim 22, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Regarding, the limitation of "said joining pieces having a geometry such that there is no internal welding required on said joining pieces"; the prior art is regarded as teaching this limitation in both embodiments. Further, upon cancellation of the new matter limitations, the prior art rejections are recited as above.

Response to Arguments

Applicant's arguments filed 8/8/06 have been fully considered but they are not persuasive.

Applicant argues that the instant invention teaches away from the method disclosed in Bland et al. and that the instant invention supplies a deficiency acknowledged in Bland et al.

However, the geometry of Bland et al. and the current invention are substantially similar. It is unclear how the current invention, more specifically the geometry of the joining pieces, supplies a deficiency in Bland et al. Further, it is unclear what "internal welding" means.

With respect to the rejection made over GB 824717, the applicant has presented no arguments or even mentioned this ground of rejection in any way. Therefore, this rejection is maintained as well.

Applicant argues that the amendment is supported by the specification.

However, applicant's comments in the pre-appeal brief request do not point to any part of the specification which details support for the amendments. Applicant points to parts of the specification that discuss the prior art. Applicant also points to parts of the specification that do not exclude internal welds. Applicant has not pointed to any part of the specification that excludes internal welds in the current invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Wartalowicz whose telephone number is (571) 272-5957. The examiner can normally be reached on 8:30-6 M-Th and 8:30-5 on Alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on (571) 272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Paul Wartalowicz
January 5, 2007

Steven Bos
Primary Examiner
A.U. 1754